

REMARKS

I. Status of the Application

Claims 1-16 are pending in this application. In the May 18, 2006 office action, the Examiner:

A. Rejected claims 1-16 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite;

B. Rejected claims 1-16 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 4,344,155 to Mollier (hereinafter "Mollier") in view of U.S. Patent No. 4,584,673 to Kuijk (hereinafter "Kuijk")

In this response, applicant has amended claims 1 and 11. Applicant respectfully traverses the rejections of claims 1-16 and requests reconsideration of the application in view of the foregoing amendments and the following remarks.

II. The Indefiniteness Rejection is Moot

The indefiniteness rejection of claims 1-16 is respectfully traversed. The arguments in the Appeal Brief filed August 15, 2005 address this issue and are incorporated herein. It is clear that the Examiner and the Applicant do not agree on this issue.

In addition, claims 1 and 11 have been amended. These amendments may address the Examiner's concern that a "test" appears to be claimed in the preamble, while the body of the claim allegedly does not contain all of the elements of a "test". With the amendments, it is made clear that the claimed elements are *used in* a test, even if they do not necessarily require that which the Examiner considers to be a complete test.

For the foregoing reasons, it is respectfully submitted that the indefiniteness rejections of claims 1 and 11 should be withdrawn. The indefiniteness rejections of claims 2-10 and 12-16 should be withdrawn for at least the same reasons.

II. The Obviousness Rejection of Claims 1 and 11 Over Mollier and Kuijk

The Examiner rejected claims 1 and 11 as allegedly being obvious over Mollier and Kuijk. As will be discussed below in further detail, it is submitted that a legally sufficient motivation or suggestion to combine Mollier with Kuijk has not been set forth in the May 18, 2006 office action.

The Examiner admitted that Mollier fails to teach or disclose a “plurality of registers” and “means for selecting which register to output”. (May 18, 2006 office action at p.7). To address this deficiency in Mollier, the Examiner relies on the teachings of Kuijk. The Examiner provided the following reasoning:

However, in an analogous art, Kuijk teaches a plurality of shift registers in which the output to the register is determined by a selector circuit (Figures 4 and 5, column 8 line 30 through column 9 line 50) therefore it would have been obvious to a person having ordinary skill in the art to have used the feedback configuration of Mollier with the selectors of a plurality of registers as taught by Kuijk. *This would have been obvious to a person having ordinary skill in the art in order to use fewer output points with a large number of registers.*

(*Id.*)

It is respectfully submitted that nothing in the prior art suggests that 1) fewer output points would be advantageous in the circuit of Mollier, 2) there is a need for fewer output points in the circuit of Mollier, and 3) that implementing the selectors of a plurality of registers as taught by Kuijk would address such a need in a circuit such as that taught by Mollier.

In particular, the Examiner has admitted that Mollier does not have a plurality of

shift registers. (*Id.*) If Mollier does not have a plurality of shift registers, then it would not appear to need a selector of the plurality of registers in order to “reduce the number of output points”. First, there must be a motivation to use a plurality of registers in Mollier, which there is none, before there could possibly be a need for a selector added to “reduce the number of output points”. Thus, unless there is a modification for including a plurality of shift registers, there cannot be motivation for added a selector. And if the motivation is to “reduce the number of output points”, one would *not* be motivated to *increase* the number of potential output points by increasing the number of shift registers.

Thus, it is respectfully submitted that the Examiner has failed to set forth a prima facie case of obviousness. For this reason, the rejection of claims 1 and 11 is in error and should be withdrawn.

IV. Claims 2-10 and 12-16

Claims 2-10 and 12-16 also stand rejected as allegedly being obvious over Mollier and Kuijk. Claims 2-10 and 12-16 all depend from and incorporate all of the limitations of one of claims 1 and 11. Accordingly, for at least the same reasons as those set forth above in connection with claims 1 and 11, it is respectfully submitted that the rejection of claims 2-10 and 12-16 should be withdrawn.

V. Conclusion

For all of the foregoing reasons, it is respectfully submitted that the application is in a condition for allowance. Favorable reconsideration and allowance of this application is, therefore, earnestly solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'H. C. Moore', with a stylized flourish at the end.

Harold C. Moore
Attorney for Applicants
Attorney Registration No. 37,892
Maginot Moore & Beck LLP
Bank One Center Tower
111 Monument Circle, Suite 3250
Indianapolis, Indiana 46204-5109
Telephone: (317) 638-2922